REMARKS

Several corrections have been made to the specification. No new matter has been introduced with these corrections, which are supported in the specification as originally filed. Claims 1 - 21 remain in the application.

I. Proposed Drawing Corrections

Proposed replacement drawings are submitted herewith for **Figs. 3B** and **4B**. The corrections made in these replacement drawings are discussed above in "Amendments to the Drawings". No new matter is introduced with these replacement drawings.

II. Rejection Under 35 U.S.C. §112, second paragraph

Paragraph 2 of the Office Action dated May 24, 2004 (hereinafter, "the Office Action") states that Claims 1 - 21 are rejected under 35 U.S.C. §112, second paragraph, as failing to set for the subject matter which Applicants regard as their invention. This rejection is respectfully traversed.

Paragraph 2 states that the claims of Applicants' invention fail to correspond to their specification. Applicants respectfully disagree and submit that their claims are consistent with the teachings of their specification, as will now be demonstrated.

Lines 2 - 4 of the final paragraph on p. 2 of the Office Action (i.e., the paragraph beginning "Evidence that claims 1 - 21 ....") cite the text "a technique wherein an EMS can

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programmatically append newly-defined or different capabilities to previously-generated events".

This text is found in Applicants' specification on p. 5, lines 3 - 4, as originally presented, and

presents one of the objects of the invention. Lines 6 - 8 of this same paragraph from the Office

Action state that "this statement indicates that the invention is different from what is defined in

the claim(s)", citing the claim language "evaluating each stored event to determine if a new or

different capability is available, and programmatically appending the new or different capability

to the stored event if so". This text is found in the third limitation of Applicants' independent

Claims 1, 11, and 16, as originally presented. Applicants respectfully submit that the cited object

of the invention is not in conflict with the third limitation of these independent claims.

The object of the invention refers to "previously-generated events". The third claim

limitation refers to those same events as "stored event[s]" which are being evaluated. (These

independent claims further specify, in the first and second limitations, that the events are

received and stored.) Both the object of the invention, and this third claim limitation, refer to

"programmatically append[ing]" capabilities to the events. The object of the invention states that

the appended capabilities may be "newly-defined or different", and this third claim limitation

uses the term "new or different" in referring to these appended capabilities. Applicants fail to see

any contradictions or conflicts here.

Lines 8 - 11 of the final paragraph on p. 2 of the Office Action state that "The invention is

directed to appending new or different capability to the event (such as presenting visible warning

messages to system operators, triggering automated execution of code to perform various tasks,

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and so forth". This is an inaccurate statement of Applicants' invention, and improperly

juxtaposes text from the background of Applicants' specification (citing p. 2, lines 18 - 20) along

with text describing novel features of Applicants' invention. That is, the background text on p. 2

does discuss "presenting visible warning messages" and "triggering automated execution of code

to perform various tasks". However, in the prior art, the visible warning messages and triggered

tasks use information that is present on the message when it arrives at the event management

system ("EMS"). Independent Claims 1, 11, and 16 of Applicants' invention specify

programmatically appending new or different capabilities to the events, after the events are

already received and stored in an event repository.

Lines 11 - 12 of this final paragraph on p. 2 of the Office Action state that the claims

specify determining "whether capability is available from the event". This is an inaccurate

characterization of Applicants' claim language and of Applicants' invention. Applicants'

independent claims do not specify capabilities available "from" an event.

The sentence that begins on line 12 of this final paragraph and carries over to line 1 of p.

3 incorrectly states that "The capability is a property". This is merely one of several potential

ways in which a capability can be programmatically appended to an evaluated event. (See, for

example, p. 6, lines 8 - 15 of Applicants' specification, where a number of options are discussed.

Dependent Claim 6 uses the claim language "a property name and value" when referring to this

option.) This sentence from the Office Action also refers to p. 4, lines 1 - 2 of Applicants'

specification. Applicants fail to see the relevance of this citation, which is explaining that prior

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art techniques (in contrast to Applicants' invention) require application writers to be explicitly

aware of the EMS capabilities and generate events accordingly, in order to invoke those

capabilities.

Lines 1 - 6 of p. 3 of the Office Action incorrectly state that "if capability is available by

evaluating the event, then there should be no need to append that to the stored event", and

discuss evaluating the management system. For clarification of an apparent misunderstanding of

their invention, Applicants respectfully refer the Examiner to the following illustrative passages:

- p. 14, lines 2 - 20 of their specification, which discuss a sample event to illustrate

  event processing according to the prior art;

- p. 15, lines 6 - 14, which discuss examples of prior art processing that may result

  from the sample event, along with a statement (see lines 13 - 14) that "no actions

  other than those actions specified by existing rules which are in effect at the time

  of receiving the event will typically execute in prior art systems"; and

- p. 16, line 2 - p. 17, line 13, which discuss examples of "new or different"

  capabilities that may be performed by recycling the sample event, according to the

  present invention.

Page 3 of the Office Action discusses Claims 3, 13, and 18, stating that these claims are

confusing. With reference to Claim 1, the "programmatically appending" might operate on an in-

memory representation of the evaluated event, whereas Claim 3 specifies that this modified

version of the event (i.e., the version with the appended information) is written to the event

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repository. Claims 13 and 18 are similar.

As has been demonstrated, Applicants' claims are not in conflict with their specification, and do not fail to correspond in scope to their specification. Applicants therefore respectfully request that the Examiner withdraw the §112, second paragraph rejection.

III. Rejection Under 35 U.S.C. §103(a)

Paragraph 3 of the Office Action states that Claims 1 - 24 (note; should state Claims 1 - 21) are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 5,063,523 to Vrenjak. This rejection is respectfully traversed.

The Office Action fails to cite any teachings for the claim limitation "... and programmatically appending the new or different capability to the stored event if so". See p. 4, lines 8 - 9 of the Office Action. Therefore, the Office Action fails to make out a *prima facie* case of obviousness; without more, Applicants' claims are deemed patentable. See Section 2143.03 of the MPEP, "All Claim Limitations Must Be Taught or Suggested", making reference to *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which stated "All words in a claim must be considered in judging the patentability of that claim against the prior art." (emphasis added). See also *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

> If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

(Applicants note that p. 4, lines 7 - 11 of the Office Action cites col. 1, line 58 - col. 2, line 5 of

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Vrenjak. However, no citation has been provided for the "programmatically appending" limitation, and the cited text from cols. 1 and 2 has no discussion nor any suggestion of any type of "programmatically appending".)

With reference to the first limitation of their independent claims, Applicants do not dispute that Vrenjak discusses receiving events. With reference to the second limitation of these claims, however, in contrast to the analysis provided on p. 4, lines 5 - 6 of the Office Action, text in Vrenjak's col. 3, lines 4 - 19 does not pertain to storing events in an event repository. The Office Action states that this cited text teaches "event table, which should be stored on memory". Applicants respectfully note that Vrenjak's Event Table 40 is a "list of valid event codes", as stated in col. 3, lines 16 - 17. A list of valid event codes is not a received event that is stored in a repository (which is Applicants' claim language): instead, it is a listing that defines the valid codes that may be present within received events.

Applicants also note that p. 4, lines 9 - 11 of the Office Action cite col. 1, line 58 - col. 2, line 5 of Vrenjak as teaching "subsequently programmatically invoking processing of the appended new or different capabilities", making reference to Vrenjak's discussion of invoking a SCRIPT command. However, Vrenjak is not discussing any "appended" capabilities, since Vrenjak has no teaching of appending anything to a received event (as discussed above). Instead, Vrenjak simply evaluates events as they are received, and takes actions that are currently applicable "upon receipt of the event". (See, for example, col. 1, line 68 and Fig. 3, reference number 204.) This is distinct from Applicants' claimed invention, which pertains to evaluating

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events that are already stored in a repository, to determine if new or different capabilities are available for those events.

Furthermore, Applicants' claim language specifically states recycling events. See, for example, the preambles of independent Claims 1, 11, 16, and 21, as well as the final limitation of each of these claims. (See also the Title of the invention.) The Office Action admits that Vrenjak does not teach recycling events. See p. 4, lines 12 - 14 of the Office Action. The Office Action continues by stating (p. 4, lines 15 - 18) that it would have been obvious to "generate least number of events if possible in order to reduce overhead and increased efficiency", since "it is well known in the art that generating event creates overhead and requires memory and execution time". Applicants respectfully submit that this supposed statement of motivation is flawed, as will now be discussed.

Applicants' invention evaluates already-stored (i.e., previously-received) events (see Claim 1, lines 2 - 5), and if the evaluation determines that new or different capabilities are available, programmatically appends information to those stored events (see Claim 1, lines 5 - 6) such that the new or different capabilities can then be invoked (see Claim 1, lines 7 - 8). In this manner, the already-stored events can be "recycled", taking advantage of the new or different capabilities, without requiring change to the application that generated the original event (see Claim 1, lines 9 - 11). As noted above, there is no teaching in the reference of programmatically appending information to an event.

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Lines 15 - 18 of the Office Action provide a hindsight-reconstruction attempt for

rendering Applicants' independent claims unpatentable. This is not allowed, as stated by the

Federal Circuit in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312–13 (Fed.

Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), which held

> To imbue one of ordinary skill in the art with knowledge of the invention
> in suit, when no prior art reference or references of record convey or suggest that
> knowledge, is to fall victim to the insidious effect of a hindsight syndrome
> wherein that which only the inventor taught is used against its teacher.

According to Applicants' invention, an event, which may have been generated responsive to an

application detecting some condition "X", can be received and stored by an EMS. Referring to

an example from Applicants' specification, an applicant might generate an "installation

successful" event. Subsequently, it may be desirable to add archiving functionality to the EMS

(as an example). Using Applicants' invention, the previously-stored "installation successful"

events can be recycled to cause all previously-installed software (as an example) to be archived.

This is so even though the previously-stored events may be completely unrelated to archival, and

the applications generating those events may have no knowledge of archival. Thus, the

applications may be completely incapable of generating any "please archive this application"

events (and there may be no condition that would cause the application to generate such an event

some time after the application has already generated the "installation successful" event). Yet,

by recycling other, previously-received events that were generated by those applications, the new

archival capability can be invoked. It is therefore not a matter of deciding that creating fewer

events would generate less overhead and less execution time, as suggested by the Office Action:

instead, Applicants' invention allows executing capabilities that the applications are incapable of

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requesting (that is, without explicitly rewriting the applications; see the final limitation of Applicants' independent claims).
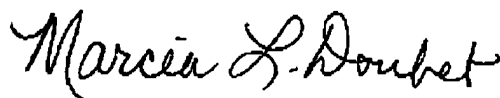
Applicants also respectfully disagree with the analysis of their dependent claims, and note that terms from these dependent claims have been ignored, in violation of the requirements set out in above-described Section 2143.03 of the MPEP, "All Claim Limitations Must Be Taught or Suggested" and *In re Wilson*. (For example, dependent Claims 2 - 8 and 10 refer to programmatically appended information, whereas the cited text from Vrenjak has no teaching of appending anything to events.) However, these are moot points, because as demonstrated above, Applicants' independent claims are deemed patentable over Vrenjak and the dependent claims are therefore patentable over this reference as well.

In view of the above, the Examiner is respectfully requested to withdraw the §103(a) rejection.

IV.   Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all claims at an early date.

Respectfully submitted,

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Attachment: Replacement Sheets (2)

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